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22879	7590	04/14/2010	EXAMINER	
HEWLETT-PACKARD COMPANY			HESS, BRUCE H	
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JERRY.SHORMA@HP.COM  
ipa.mail@hp.com  
laura.m.clark@hp.com



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/613,495

Filing Date: July 02, 2003

Appellant(s): CHEN ET AL.

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Carol Mintz  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 12, 2010 appealing from the Office action mailed October 20, 2009.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 1-4, 6 and 7.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief. The IDS submitted on 03/03/2010 after the filing of the appellants' brief has been considered. The references discussed in the Japanese Search Report are not considered to be as relevant as the reference relied upon by the examiner.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office

action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

The evidence relied upon by the examiner in the rejection of the claims under appeal is applicants' Declaration of 08/24/2005. The claims are rejected over applicants' statement of the prior art.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6 and 7 are rejected under 35 USC 103(a) as being unpatentable over applicants' statement of the prior art.

In their Declaration of 08/24/2005, applicants acknowledge that "Neither the composition nor the paper base used in this invention is new ...". The presence of mordants in this composition clearly identifies the composition as one that is ink receiving. Applicants further acknowledge on pages 1 and 2 of their specification that it is conventional for ink jet recording media to employ coated base papers having ink receiving layers that contain hydrophilic binders, hardening agents and mordants. Consequently, use of a known ink jet recording media base with a known ink jet

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recording layer would have been obvious to one of ordinary skill in this art in the absence of unexpected results.

**(10) Response to Argument**

Applicants argue that the prima facie case of obviousness established by the examiner has been overcome by a showing of unexpected results in Example 5 in their specification. The examiner acknowledges that applicants have in fact shown that unexpected results are obtained when the claimed ink receiving layer a) contains boric acid as a cross-linking agent and b) is applied to the claimed paper bases in an amount of 5.5 grams per square meter. This showing is not commensurate in scope with applicants' claims which can employ cross-linking agents other than boric acid or its salts and the receiving layer can be applied in a range of "about 3 grams per square meter to about 7 grams per square meter".

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/BRUCE H. HESS/

Primary Examiner, Art Unit 1785

Conferees:

/William Krynski/

Quality Assurance Specialist, TC1700

/Mark Ruthkosky/

Supervisory Patent Examiner, Art Unit 1785